

REMARKS

In the Office Action dated April 28, 2003, claims 1-49 were presented for examination. Claims 1-15 and 43-49 were objected to based upon a supposed informality. Claims 1-5, 8, 10-20, 23-28, 30-35, and 37-49 were rejected under 35 U.S.C. § 102(a) as being unpatentable over *Mack*. Claims 6, 7, 9, 21, 22, 29, and 36 were objected to as being dependent upon a rejected based claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim.

Applicants wish to thank the Examiner for the careful and thorough review and action on the merits in this application.

I. Priority Claim

The Office Action Summary made an acknowledgment of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f), and receipt of all of the certified copy of the priority documents. However, Applicant is a domestic entity and has not made a claim to a foreign priority. Rather, Applicant has made a claim for domestic priority under 35 U.S.C. § 119(e) to a provisional application. Correction of the priority claim is respectfully requested.

II. Specification

The Examiner has objected to the Abstract of the disclosure because the phrase "adapted to" is present in the body of the Abstract. However, the Examiner has not provided a legal precedent, statutory basis, or legislative basis for the objection and requirement of removal of such language from the Abstract. Accordingly, Applicants respectfully request that the Examiner either remove the objection to the Abstract or provide legal support to the Examiner's objection in the next Office Communication.

Furthermore, the Examiner objected to the placement of the title of the invention on top of the Abstract. Applicants have amended the Abstract accordingly, and respectfully requests that the Examiner remove this objection.

III. Claims

The Examiner has objected to claims 1-15 and 43-49 because the phrase "adapted to" is present therein. However, the Examiner has not provided a legal precedent, statutory basis, or legislative basis for the objection and requirement of removal of such language from the claims. Accordingly, Applicants respectfully request that the Examiner either remove the objection to the claims or to provide legal support for the objection in the next Office Communication.

IV. 35 U.S.C. §102(b) - Anticipation by *Mack*

Claims 1-5, 8, 10-20, 23-28, 30-35, and 37-49 were rejected under 35 U.S.C. §102(a) as being unpatentable over *Mack*.

The *Mack* article relates to robotic apparatus in a surgical environment. More specifically, the article is an oversight of advancement in robotics in surgery of which some are current and some are forecasts of future developments. *Mack* discloses a forced feedback closed loop system to enable a surgeon to decisively determine a subsequent surgical step based upon the feedback from the system. The surgeon's handle is an input console to sense movement of the input device, i.e. the handle. It is movement of the handle, whether from the surgeon or an alternative force, that communicates with a remote surgical implement. Accordingly, *Mack* is an article that provides an overview of a robotic input device for an assistive surgical procedure.

Applicant's invention differs from the disclosure of *Mack*. Applicant's invention has a biometric sensor that senses biological phenomena and transmits the motion associated therewith to an actuator of a robotic apparatus. A biometric sensor senses characteristics associated with a living organism. The sensor of Applicants is a sensor that senses biological movement. *Mack* does not sense movement by the use of a biometric sensor. *Mack* senses movement of a tool that is in communication with a robotic implement. The sensor in *Mack* is not the tool, rather the sensor is within the tool that senses movement of the tool. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)). As mentioned above, *Mack* does not show all of the elements as claimed by Applicants. Specifically, *Mack* does not suggest or teach a biometric sensor in communication with an actuator of a robotic apparatus. Accordingly,

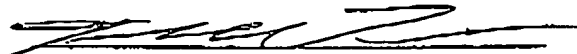
Mack fails to teach all the claim limitations present in Applicant's claimed invention. Accordingly, removal of the rejection of claims 1-5, 8,10-15, and 43-49 under 35 U.S.C. §102(a) as being anticipated by *Mack* is respectfully requested.

The Examiner indicated that the subject matter in claims 6, 7, 9, 21, 22, 29, and 36 as being allowable if rewritten in independent form to include all of the limitations of the base claim. Applicants have amended claims 16 to incorporate the part of the subject matter of claim 21 as discussed with the Examiner. In addition, Applicants have amended claim 32 to incorporate the subject matter of claim 36 as discussed with the Examiner. Accordingly, Applicants have amended independent claims 16 and 32 in view of the limitations as discussed with the Examiner during the interview of July 28, 2003, and therefore respectfully requests removal of the rejection of claims 16-20, 23-28, 30-35, and 37-43 under 35 U.S.C. §102(a).

In light of the foregoing amendments and remarks, all of the claims now presented are in condition for allowance, and Applicants respectfully request that the outstanding rejections be withdrawn and this application be passed to issue.

The Examiner is urged to call the undersigned at the number listed below if, in the Examiner's opinion, such a phone conference would aid in furthering the prosecution of this application.

Respectfully submitted,



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